REMARKS

Claims 1 to 22 are pending. Claims 17 to 22 have been withdrawn from consideration. By this response, claims 1, 3 and 4 are amended, and claim 2 has been canceled. New claim 23 has been added. Applicants respectfully request reconsideration of the claim in light of the foregoing amendments and the following remarks.

Claim Amendments

Claim 1 has been amended to incorporate the limitiations of claim 2. Claims 3 and 4 have been amended to clarify the claims. New claim 23 recites that the shaping step comprises coating the emulsion onto a substrate. Support for the new claim is found, for example, on page 5, lines 14-15, and on page 8, lines 18-19, of the specification. No new matter has been added by the amendments.

§ 102 / § 103 Rejections

Claims 1-6 stand rejected under 35 USC § 102(b) as being anticipated by any of von Bonin et al. (USPN 3,255,127), Will (USPNs Re 27,444; 3,256,219; and 3,734,867), Lissant (USPN 3,988,508) or Dyer et al. (USPN 5,922,780). Claims 1-16 stand rejected under 35 USC § 103(a) as being unpatentable over these references alone or in combination. Applicants respectfully traverse these rejections as applied to the amended version of the claims.

A patent claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Furthermore, in order to establish a *prima facie* case of obviousness, the Patent Office must demonstrate that (1) there is a suggestion or motivation in the prior art to modify or combine reference teachings, (2) one skilled in the art would have had a reasonable expectation of success in making the modification or combination, and (3) the prior art reference(s) disclose all of the claim limitations. The fact that one of ordinary skill in the art would have had the capability to modify the method disclosed in the prior art reference(s) is not sufficient. MPEP 2143.01. The prior art reference(s) must provide a motivation or reason for making the changes. MPEP 2142; *Ex parte Chicago Rawhide Manufacturing Co.*, 226 USPQ 438 (PTO Bd. App. 1984). Since, as explained below, the prior art cited by the Examiner fails to provide all of the

limitations of the present invention, and there would be no motivation for a skilled artisan to combine the cited references with a reasonable expectation of success, the § 102 and § 103 rejections should be withdrawn.

Lissant

The Examiner asserts that Lissant "discloses a process of making a water in oil polymer from a polymerizable monoethyleneically unsaturated monomer." (Office Action, p. 3). However, Lissant appears to be describing an oil-in-water system, not a water-in-oil system. In particular, Lissant describes "forming an emulsion of monomer in an aqueous system" (col. 1, line 66 to col. 2, line 4). Indeed, claim 1 of the Lissant patent is directed to a process of emulsion polymerization comprising forming a "monomer-in-water emulsion," i.e. an oil-in-water system. Thus, in the Lissant system, the discontinuous phase is the reactive phase (the monomer), which is exactly the opposite of the system recited in present claim 1, in which the reactive phase is continuous. Lissant, therefore, does not disclose all of the limitations recited in the present claims.

von Bonin and Will

As amended, claim 1 recites a polymerization process that utilizes a photoinitiator system. Neither von Bonin nor Will disclose the use of a photoinitiator system or any form of photopolymerization. Although the Lissant reference, discussed above, mentions in one example exposing the compositions to daylight for a period of about 4 months, there is no disclosure of the use of a photoinitiator system to effect polymerization. Consequently, even if von Bonin and/or Will, were combined with each other or with Lissant, the combination would still fail to describe all of the limitations of claim 1.

Moreover, even if the Examiner believes that Lissant discloses some sort of photopolymerization or photoinitiator system, a skilled artisan would not have been motivated to use a photoinitiator with a reasonable expectation of success in the von Bonin or Will systems because water-in-oil systems typically have greater opacity than oil-in-water systems making the use of photoinitiators more difficult. Thus, the present invention is patentable over these references.

Dyer

The present claims are directed to a "process for making an uncrosslinked polymeric foam." Dyer, on the other hand, describes crosslinked polymers made from 1,3,7-octratriene and similar conjugated polymers. In particular, Dyer states:

> Because the monomer mixture includes a crosslinking agent, the polymers prepared according to the present invention are thermosetting. These thermosetting polymers will not flow at higher temperatures to any large degree, are generally not extrudable, and are generally amorphous. (Emphasis added.)

Since Dyer uses a crosslinking agent, the Dyer process produces polymers that are thermosetting, i.e. cannot be melted. In contrast, the process of the present invention, as explained on page 7 of the specification, has the advantage of be able to provide non-crosslinked porous foam materials that can be melted such that the cell structure collapses to form a continuous clear film.

In addition, as with the von Bonin, Will, and Lissant references discussed above, Dyer fails to teach or suggest the use of a photoinitiator system. Furthermore, it would not have been obvious to incorporate such a system into the Dyer compositions, because Dyer teaches the use of adjuvants, such as Hingered Amine Light Stabilizers (HALS), that are incompatible with a photopolymerization system. For these reasons, Applicants respectfully submit that the present claims are patent over Dyer, alone or in combination with the other cited references.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance. Reconsideration of the application is requested.

All communications in this case should be direct to the undersigned. If the Examiner believes a telephone discussion would be helpful to resolve any of the outstanding issue in this case, the Examiner is encouraged to call the undersigned at the number listed below.

Respectfully submitted,

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